

REMARKS

Claims 1-20 are pending in the present application.

At the outset, Applicants wish to thank the Examiner for apparently withdrawing the previous rejections of the claims as being obvious over JP 08168337 (cited as JP 08168537) in view of Shaklai and Kowalski and being indefinite. Applicants also wish to thank the Examiner for the helpful and courteous discussion with their undersigned Representative on February 15, 2005. During this discussion, the Examiner explained the basis for the “new matter” rejection. The content of this discussion is reflected in the comments set forth below.

The rejection of Claims 1-2 and 5-11 under 35 U.S.C. §112, first paragraph (written description/new matter) and the objection to the specification as containing “new matter” is respectfully traversed.

First, Applicants wish to note that even though the priority application does not specifically recite the range of 1100 to 2400 µg/kg, the priority application unequivocally evidences that a global character error occurred in that “µg/kg” inadvertently was reproduced as “mg/kg.” Specifically, Applicants direct the Examiner’s attention to the several occurrences at pages 26, 27, and 34 of the present specification, which irrefutably find support in paragraphs [0039], [0040], [0051] (including Table II), and [0052] of the priority application. Included in these occurrences are two instances at page 27, line 6-8 and page 27, line 11-14, which define the upper limit of the CO concentration to be 2400 µg/kg. Accordingly, the units for the *lower* limit must also find support in the priority application, even in the absence of an explicit recitation of 1100 µg/kg in the priority application. As such, the correction of the error in the units would not constitute “new matter.”

Second, during the discussion with the Examiner it was indicated that the Examiner's position is that the new matter rejection extends beyond the units and relates to the recitation of the range 1100 to 2400 $\mu\text{g/kg}$ in the *original* specification and claims (see also page 2, lines 3-8 and page 3, lines 3-4 of the November 24, 2004). It is apparently the Examiner's position that the *original* specification and claims contain new matter, because the "original translated JP application (attached) disclosed a range of only 1500 to 2400 $\mu\text{g/kg}$."

Applicants are perplexed as to how the original specification and claims can contain new matter, when the introduction of new matter requires comparing an amendment to the "application as filed" (see MPEP §2163.06). In this case, the broader range (i.e., 1100 to 2400 $\mu\text{g/kg}$) is present in the application as filed and, therefore, cannot be new matter.

Based on the foregoing, it appears that the Examiner is confusing "new matter" with entitlement to priority. In this instance, the only question should be whether the broad range is entitled to priority based on the disclosure of JP 2001-1644. Clearly, as recognized by the Examiner, 1500 to 2400 $\mu\text{g/kg}$ is, *in fact*, recited in JP 2001-1644 and is entitled to this earlier date. Therefore, the priority question can be narrowed to whether the range of 1100 to less than 1500 $\mu\text{g/kg}$ is also entitled to the benefit of an earlier priority date based on the disclosure of JP 2001-1644. However, in any circumstance, since 1100 to 2400 $\mu\text{g/kg}$ ¹ appears in the specification as filed, there can be no new matter issue.

Applicants request withdrawal of this ground of rejection.

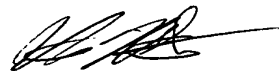
¹ Of course, after correction of the global character error in the term " $\mu\text{g/kg}$."

In regard to new Claims 12-20, Applicants note that these claims depend from Claim 11 and correspond to original Claims 2-10. As such, these claims are free of the art of record for the same reason as Claims 1 and 11. Moreover, based on their dependency upon Claim 11, these claims do not raise new issues for consideration and should be entered. Further, Claims 3 and 4 directly depend from and further define Claims 1 and 2, respectively. Since Claims 3 and 4 share the same point of novelty (i.e., the limitations of Claims 1 and 2, respectively), these claims should be rejoined and allowed with Claims 1 and 2. Acknowledgement to this effect is requested.

Applicants submit that the present application is now in condition for allowance. Early notification of such action is earnestly solicited.

Respectfully submitted,

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